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Date: March 26, 2003

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To:	Michael L. Lewis	**Fax No.**	703-746-9194
To:		**Fax No.**	
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MESSAGE:

Attached please find the Response to Petition for Access to Pending Application File Wrapper.

If you experience any problems in receiving any of these pages, please call the Copy Center as soon as possible, (317) 684-5144. Thank You.

Operator Initials: _____

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PATENT TRADEMARK OFFICE

BOSE McKINNEY & EVANS LLP

2700 First Indiana Plaza
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Indianapolis, Indiana 46204
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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit:	2165
Atty. Docket:	10252-0013
Applicant:	Hill
Title:	ELECTRONIC CATALOG SYSTEM AND METHOD
Serial No.:	09/618,744
Filed:	July 18, 2000

Certificate Under 37 C.F.R. § 1.8(a)

I hereby certify that this correspondence is being transmitted by facsimile to the Office of Patent Legal Administration at (703) 746-9194

on March 26, 2003

A. Vornheder

A. Vornheder

Dated: March 26, 2003

RESPONSE TO PETITION FOR ACCESS TO PENDING APPLICATION FILE WRAPPER

Attn: Office of Patent Legal Administrator/Michael L. Lewis
Assistant Commissioner of Patents
Box DAC
Washington, D.C. 20231

Sir:

In response to the communication from the Patent Office dated March 5, 2003, entitled "Three Week Letter", Applicant respectfully objects to the Petition for Access to Pending Application Serial No. 09/618,744 (Pending). The above-referenced application does not qualify for public-access by "special circumstances" under 37 C.F.R. § 1.14(j) or under 37 C.F.R. § 1.183 as alleged by Petitioner.

1. Patent applications are preserved in confidence by the U.S. Patent Office, 35 U.S.C. § 122.

"Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without the authority of the Applicant or owner..." 35 U.S.C. § 122. Only in special circumstances prescribed by the Patent and Trademark Office is this cornerstone rule not followed. Applicant respectfully submits that substantial and irreparable harm could result if the above-referenced application is disclosed to Petitioner as a result of the Petition.

2. Petitioner has not shown "special circumstances" to warrant the disclosure of the above-referenced application.

Petitioner alleges that access to the above-referenced application should be permitted under 37 C.F.R. § 1.14(j). This rule provides that the Patent and Trademark Office may provide access to pending or abandoned applications "if warranted by special circumstances", 37 C.F.R. § 1.14(j). No such special circumstances exist in this instance.

Petitioner and Applicant are currently involved in litigation concerning several patents related to the above-referenced application. These patents include U.S. Patent No. 5,528,490, U.S. Patent No. 5,761,649, and U.S. Patent No. 6,029,142. This litigation has not entered the discovery phase wherein the Petitioner and Applicant exchange discoverable documents. It is anticipated that discovery will begin in April or May 2003. If requested by Petitioner in this litigation and if responsive and discoverable, the above-referenced application, including prior art, will be provided to the Petitioner in due course after discovery begins.

Thousands of patent infringement lawsuits are filed each year and many of the patents involved in these lawsuits include continuation applications, similar to those involved in this case. Petitioner does not set forth any reasons why this is a "special circumstance" which requires access to the application file history compared to the many other patent infringement lawsuits involving continuation applications. The Court system is adequately equipped and experienced in dealing with this type of situation during the discovery period of a lawsuit where the rights and interests of the Applicant can be adequately protected. Thus, no "special circumstances" exist which warrant access to the application file history outside of the normal litigation discovery process.

3. Production of the above-referenced application under a protective order within the litigation process preserves the Applicant's rights.

If, during discovery, the above-referenced application is provided to Petitioner, a protective order or other type of confidentiality agreement would protect Applicant against public disclosure of the information found in the application file wrapper. For example, the protective order will likely include an "Attorney's eyes only" designation which, when applied to confidential documents such as the above-referenced application, will prevent the public, including Petitioner's clients, from reviewing the file history. For this reason, Applicant will not suffer any harm if the application file history is produced during the discovery phase of litigation under such a protective order, unless Petitioner violates the protective order. Further, within the timeline of the related litigation, the Petitioner will, subject to normal discovery issues, receive the above-referenced application in a timely manner.

For at least these reasons, Applicant respectfully requests that Petitioner's petition for access to the file history and the prior art be denied.

Respectfully submitted,

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